

II. Interview Summary

The Examiner conducted a telephonic interview with Applicants' representative, Mark Sweet, on November 19, 2003.^{1,2} During the telephonic interview, the Examiner and Applicants' representative discussed the language "substantially chlorine free," "substantially moisture free," and "substantially pure" and the requirements of 35 U.S.C. § 112, first and second paragraphs.

Applicants' representative declined during the telephonic interview to amend the claims of this application any further, and requested that the Examiner issue an Office Action setting forth the reasons why the claim language quoted above does not meet the requirements of 35 U.S.C. § 112, first and second paragraph. For the reasons set forth below, Applicants respectfully submit that the language rejected by the Examiner meets the requirements of § 112.

III. Rejections Under 35 U.S.C. § 112

a) First Paragraph

Claim 18 has been rejected under 35 U.S.C. § 112, first paragraph. As an initial matter, it is unclear to Applicants which provision of § 112, first paragraph is being relied upon for this rejection. The statement of the rejection indicates that claim 18 was rejected "for failing to comply with the **written description** requirement." Office Action at 2 (emphasis added).

¹ Applicants note that the Interview Summary form is entitled "*Ex Parte* Reexamination Interview Summary." This appears to be in error as the present application is not the subject of a reexamination proceeding.

² The Interview Summary form also indicates that "Attorney M. Smith" was a participant in the telephonic interview with Examiner Pryor. This is in error, as Mark Sweet participated in this call. Page 2 of the Office Action correctly indicates this fact.

However, the following paragraph, which appears to set forth the rationale of the rejection, is directed to enablement, and not written description. Specifically, this paragraph states that the specification,

while being **enabling** of making difluoromethane, does not reasonably provide description as to what substantially chlorine [free], [substantially] moisture free, or substantially pure mean. The **specification does not enable** any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

Id. (emphasis added). Despite the lack of clarity in the Office Action, in an attempt to advance prosecution of this case, Applicants set forth below the reasons why the language “substantially chlorine free,” “substantially moisture free,” and “substantially pure” meet the requirements of § 112.

i) Written Description

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. M.P.E.P. § 2163, I. Moreover, there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. M.P.E.P. § 2163, I. A.

In the present case, the language “substantially chlorine free,” “substantially moisture free,” and “substantially pure” find literal support in the specification as filed. See, for example, page 2, line 22 (“substantially pure”), page 6, line 23 (“substantially chlorine-free”), page 6, line 26 (“substantially moisture-free”), and claim 18 as originally

filed. Accordingly, this literal support in the specification as filed clearly shows that Applicants had possession of the invention at the time of filing.

ii) Enablement

The overall “test of enablement” is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent application coupled with information known in the art without undue experimentation. See M.P.E.P. § 2164.01. With regard to the present specification, the disclosure details methods that can be used to produce a “substantially chlorine free” product, a “substantially moisture free” product, and “substantially pure” difluoromethane. See, e.g., the specification at page 6, line 12 through page 7, line 2, and the examples. Based upon this disclosure and the knowledge of one skilled in the art, Applicants submit that the specification enables methods of making and using the claimed “substantially chlorine free” product, “substantially moisture free” product, and “substantially pure” difluoromethane without undue experimentation.

Moreover, according to M.P.E.P. § 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. The Examiner may do so by making specific findings of fact, supported by evidence, and then drawing conclusions based on these findings of fact. As stated in M.P.E.P. § 2164.01(a), there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any experimentation is “undue.” These factors, known as the *Wands* factors, include, but are not limited to: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the

level of ordinary skill; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. M.P.E.P. § 2164.01(a), citing *In re Wands*, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir 1988)).

Additionally, Applicants note that “a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.” *In re Wands*, 8 U.S.P.Q.2d at 1404. In evaluating these *Wands* factors, the Examiner’s analysis must consider all the evidence related to each one of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.

The outstanding Office Action contains no such evaluation of the *Wands* factors. If the Examiner, as required, applied and weighed the *Wands* factors, Applicants submit the Examiner must conclude that the present disclosure sufficiently enables one of ordinary skill to practice the claimed invention. Even if some experimentation was needed, it would not be considered undue at least because of the guidance provided by the specification and the knowledge of one of ordinary skill in the art. In other words, after the Examiner evaluates each of the *Wands* factors above as applied to the claims as a whole, sufficient guidance for one of skill in the relevant art to prepare and use the claimed “substantially chlorine free” product, “substantially moisture free” product, and “substantially pure” difluoromethane without undue experimentation will be found.

Applicants therefore respectfully request reconsideration and withdrawal of the rejection under § 112, first paragraph.

b) Second Paragraph

Claim 18 has also been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In making this rejection, the Examiner states that the “phrases ‘substantially free’ and ‘substantially pure’ in [claim 18] are [] relative phrases which render[s] the claim indefinite.” Office Action at 3. Applicants respectfully disagree with this rejection.

To meet the requirements of § 112, second paragraph, the claims must

define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

M.P.E.P. § 2173.02. In making this analysis, the claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

The term “substantially” is often used in conjunction with another term to describe a particular characteristic of the claimed invention, and the use of the term “substantially” in conjunction with another term has been found by the Federal Circuit to be definite. See M.P.E.P. § 2173.05(b) *D.* For example, in *Andrew Corp. v. Gabriel Electronics, Inc.*, 6 U.S.P.Q.2d 2010 (Fed. Cir. 1988), which was cited in M.P.E.P. § 2173.05(b) *D.*, the Federal Circuit held that the term “substantially equal” was definite.

In reaching this conclusion, the court pointed to *Seattle Box Co. v. Industrial Crating & Packing*, in which the court “remarked that ‘substantially equal’ is a term of degree, and that its acceptability depends on ‘whether one of ordinary skill in the art would understand what is claimed . . . in light of the specification, even if experimentation may be needed.’” *Seattle Box Co. v. Industrial Crating & Packing*, 221 USPQ 568, 573-74 (Fed.Cir.1984). In *Andrew Corp.*, the court also pointed out that the subject matter need only be defined as precisely as the subject matter permits. *Andrew Corp.*, 6 U.S.P.Q.2d at 2014.

In the present case, Applicants submit that the phrases “substantially free” and “substantially pure” would have been understood by one of ordinary skill in the art. As emphasized above, the specification provides guidance how to produce a “substantially moisture free” and “substantially pure” product. Moreover, the phrases were defined as precisely as their subject matter permits. Accordingly, Applicants submit that neither the rejection nor the law supports the Examiner’s position that one of ordinary skill in the art would not know when the produced products are “substantially moisture free” or “substantially pure.”

Thus, for at least the foregoing reasons, Applicants respectfully submit that the rejections under § 112, second paragraph, is in error and should be withdrawn.

CONCLUSION


In view of the foregoing remarks and the Examiner’s indication of allowable subject matter in the outstanding Office Action, Applicants respectfully submit that this application is in condition for allowance.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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